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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,099	12/08/2003	Kia Silverbrook	BAL71US	8770

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

WHIPKEY, JASON T

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,099

Applicant(s)

SILVERBROOK ET AL.

Examiner

Jason T. Whipkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 10-31 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/113,057.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-5, 7, 9, 32, and 33 have been considered but are moot in view of the new grounds of rejection.

Applicant also argues on page 11 of the remarks filed January 24, 2005, that "there is specific disclosure of scanning printheads (inkjet head 5 in Suzuki and print cartridge 22 in Purcell), which in fact teach away from [the] feature" of a pagewidth printhead.

The examiner notes that the references do not "teach away from this feature" simply because they do not disclose a pagewidth printhead. Requiring such a disclosure is not consonant with the public policy underlying 35 U.S.C. 103. The statute, by its very nature, entails modifying disclosed inventions to show unpatentability.

Terminal Disclaimer

2. The terminal disclaimer filed on January 24, 2005, disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of any patent granted on Application Number 10/729,097 has been reviewed and is accepted. The terminal disclaimer has been recorded.

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Priority

3. Acknowledgment is made of Applicant's claim for foreign priority based on an application filed in Australia on July 15, 1997. While parent application 09/113,057 includes a certified copy of application PO7986, it is noted that Applicant has not filed a certified copy of the PO7991 application as required by 35 U.S.C. 119(b).

Claim Objections

4. The amendment to claims 22, 30, and 31 have vitiated the objections to the claims. The objections are therefore withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5, 7, 9, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Application Publication No. 2003/0043273) in view of Purcell (U.S. Patent No. 6,227,643) and Granzow (U.S. Patent No. 5,751,318).

Regarding **claim 1**, Suzuki discloses a handheld camera (see Figure 1) arranged for housing a print roll (24; see paragraph 55) for dispensing print media (print sheet 11; see *id.*), said camera comprising:

a sensor (CCD 40) adapted to sense an image; and

a printer (P) for printing images on print media (print sheet 11; see paragraph 55).

Suzuki is silent with regard to the print roll including a chip.

Purcell discloses:

a print roll (Figure 8; see column 8, lines 44-45), the print roll comprising a chip (memory element 140) having predetermined information stored thereon (see column 9, lines 30-40 and 65-67, and column 10, lines 1-27);

a processing system (processor 52) adapted to:

obtain an image (see column 4, lines 59-61); and

cause the image to be printed on the media in accordance with the predetermined information (for example, memory element 140 may store

the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

As stated in column 9, line 65, through column 10, line 8, an advantage to storing data on a chip included on a print roll is that properties of the print roll may be transferred between printing devices along with the roll. For this reason, it would have been obvious at the time of invention to have Suzuki's camera read data from a print roll including a chip.

Both Suzuki and Purcell are silent with regard to the printer having a pagewidth printhead.

Granzow discloses a pagewidth printhead 10, as shown in Figure 1. As stated in column 3, lines 57-66, advantages of using a pagewidth printhead include increased reliability, speed, and quality. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the printers described by Suzuki and Purcell include a pagewidth printhead.

Regarding **claim 2**, Purcell discloses:

the predetermined information comprising at least one of: Factory Code; Batch Number; Serial Number; Manufacturing date; Media length; Media Type; Pre-printed Media Length; Ink Viscosity; Recommended Drop Volume; Ink Color; and, Remaining Media Length Indicator (memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

Regarding **claim 3**, Purcell discloses:

the processing system being adapted to control the printing in accordance with the predetermined information (memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

Regarding **claim 4**, Purcell discloses:

the processing system being adapted to: manipulate the image in accordance with the predetermined information; and, cause the manipulated image to be printed on the media (print data may be modified to correct its color based on the stored paper color; see column 10, lines 9-27).

Regarding **claim 5**, Purcell discloses:

the camera comprising a guillotine (automatic cutting knife 64; see column 4, line 65) the processing system being adapted to activate the guillotine to cut media from the print roll (as shown in Figure 2, processor 52 controls cutting knife 64 via drive circuits 60).

An advantage to including a guillotine to cut media from the print roll is that a more presentable print may be produced for the user, as the user is not required to cut the media manually. For this reason, it would have been obvious at the time of invention to have Suzuki's camera include a guillotine.

Regarding **claim 7**, Suzuki discloses:

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A handheld camera as claimed in claim 5, the camera comprising a print roll drive system (see the various rollers in Figure 1) for dispensing the media (print sheet 11) along a print path, the printer being positioned in the print path (see Figure 1).

Regarding **claim 9**, Suzuki discloses:

A handheld camera as claimed in claim 1, the camera comprising a housing (1a in Figure 2) adapted to receiving the print roll (see Figure 2).

Regarding **claim 32**, Suzuki discloses a method of operating a handheld camera (see Figure 1), the method comprising:

- causing a sensor (CCD 40) to sense an image;
- obtaining the image from the sensor (see paragraph 58); and
- printing the image on media (print sheet 11; see paragraph 55) dispensed from a print roll (24; see *id.*)

Suzuki is silent with regard to the print roll including a chip.

Purcell discloses:

- a print roll (Figure 8; see column 8, lines 44-45) comprising a chip (memory element 140) having predetermined information stored thereon (see column 9, lines 30-40 and 65-67, and column 10, lines 1-27), the printing being performed in accordance with the predetermined information (for example, memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

As stated in column 9, line 65, through column 10, line 8, an advantage to storing data on a chip included on a print roll is that properties of the print roll may be transferred between printing devices along with the roll. For this reason, it would have been obvious at the time of invention to have Suzuki's camera read data from a print roll including a chip.

Both Suzuki and Purcell are silent with regard to the printer having a pagewidth printhead.

Granzow discloses a pagewidth printhead 10, as shown in Figure 1. As stated in column 3, lines 57-66, advantages of using a pagewidth printhead include increased reliability, speed, and quality. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the printers described by Suzuki and Purcell include a pagewidth printhead.

Regarding **claim 33**, Purcell discloses:

A method as claimed in claim 32, the method comprising: manipulating the image in accordance with the predetermined information; and, causing the manipulated image to be printed on the media (print data may be modified to correct its color based on the stored paper color; see column 10, lines 9-27).

Allowable Subject Matter

8. Claims 6, 8, 10-31, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Regarding claim 6, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information and a guillotine that is activated in response to a detected attempt to pull the print media from the camera.

Regarding claim 8, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information and a guillotine that is activated in response to the print media being dispensed at a faster rate than the print roll drive system.

Regarding claims 10-31 and 34, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the print roll contains a chip storing authentication information used to authenticate the print roll prior to printing.

Conclusion

9. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

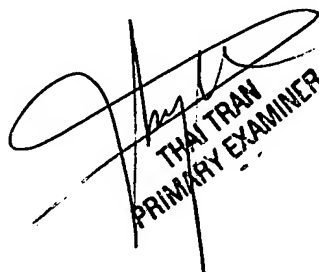
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran, can be reached at (571) 272-7382. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTW

JTW

September 12, 2005


THAI TRAN
PRIMARY EXAMINER